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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,841	12/31/2001	Toshihiko Yamashita	YAMA3020/FJD	8728
23364 7590 08/17/2007 BACON & THOMAS, PLLC 625 SLATERS LANE FOURTH FLOOR ALEXANDRIA, VA 22314				
EXAMINER				
CHIRISS, JENNIFER A				
ART UNIT		PAPER NUMBER		
1771				
MAIL DATE		DELIVERY MODE		
08/17/2007		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/926,841

Applicant(s)

YAMASHITA ET AL.

Examiner

Jennifer A. Chriss

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5,6 and 9-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-6,9-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's Amendments and Accompanying Remarks filed on 8/3/07 has been entered and carefully considered. Claims 5 and 9 are amended and claims 5 – 6 and 9 – 11 are pending. In view of Applicant's claim amendments, the Examiner has revised the previously applied rejection below. The invention as currently claimed is not found to be patentable for reasons herein below.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 5 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

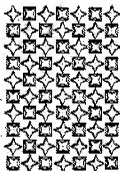
applicant regards as the invention. Claims 6 and 10 – 11 are rejected as being dependent on claims 5 and 9.

5. Regarding claims 5 and 9, the phrase "or the like" renders the claims indefinite because the claims include elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claims unascertainable. See MPEP § 2173.05(d).

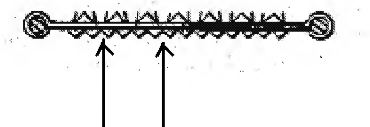
Claim Rejections - 35 USC § 103

6. Claims 5 – 6 and 9 – 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woodward (US 165,143).

Woodward is directed to a culinary grater (Title) comprising a sheet of metal having perforations on both sides, the holes on each side alternating with depressed perforations that form the grating surface on the opposite side (column 1). It should be noted that the Examiner equates the holes alternating with depressed perforations is equated to Applicant's "concave and convex portions opposite to and adjacent to each other". As shown in the figure below, each perforation has a petaloid configuration consisting of 4 petal-like portions.



As shown by the arrows in the figure below, the grater has v-shaped valleys between adjacent petaloid shaped pieces.



As to the recitation that the thin meshy porous body is "for a core member for a battery electrode, various filter members, or the like", it should be noted that the recitation is not given patentable weight at this time since the prior art meets the structural limitations set forth and there is nothing on record to evidence that the prior art product could not function in the desired capacity or that there is some additional implied structure associated with the term. The burden is shifted upon the Applicant to evidence the contrary.

Woodward discloses the claimed invention except for thickness is between 10 – 50 micrometers, longitudinal length of the openings is 365 – 510 microns, the lateral length of the openings being 360 – 510 micrometers, the opening ratio is between 45 – 60% and peak-to-peak dimension between adjacent convex portions is approximately 550 μm . Absent a showing of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to create a substrate with a thickness of 10 – 50 micrometers, an opening length of 360 to 510 micrometers the opening ratio is between 45 – 60% and peak-to-peak dimension between adjacent

convex portions is approximately 550 um since it has been held that where general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 220 F.2d 454 USPQ 233 (CCPA 1955). In the present invention, one would have been motivated to optimize the thickness, opening length and opening ratio in order to create a mesh with an optimal level of porosity and rigidity.

Response to Arguments

7. Applicant's arguments filed 8/3/07 have been fully considered but they are not persuasive.
8. Applicant argues that a food grater is not a battery electrode, or a filter member or anything that would be considered as "or the like". The Applicant fails to provide a clear definition of "core member of a battery electrode", "various filter members" or "or the like" in the Specification. Absent a clear definition, the phrase "core member for a battery electrode", "various filter members" and "or the like" may be given its broadest reasonable meaning. For example, a filter in a broad sense is a porous article that can be used to separate material that is passed through the porous article. The food grater of Woodward performs such a function when food is being grated. Also, the Examiner submits that such a recitation alone does not impart any physical and/or chemical structure to the claims. In light of this, it should be noted that the Examiner has given no patentable weight to "core member of a battery electrode, various filter members or the like". It has been held that a claim containing a "recitation with respect to the manner in

which a claimed article is intended to be employed does not differentiate the claimed article from a prior art article if the prior art article teaches all the structural limitations of the claim". *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987). It should be noted that Woodward meets the structural and/or chemical limitations set forth and there is nothing on record to evidence that the prior art product could not function in the desired capacity or that there is some additional implied structure associated with the term. The burden is shifted upon the Applicant to evidence the contrary.

9. Applicant cites a decision of the Federal Circuit noted on August 1, 2007 but has not provided any documentation of this decision. If Applicant wants the Examiner to give full consideration to decision, please provide a copy in the next response.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer A. Chriss whose telephone number is 571-272-7783. The examiner can normally be reached on Monday - Friday 8 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571 - 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elizabeth M. Cole/
Primary Examiner, Art Unit 1771

/Jennifer A Chriss/
Examiner, Art Unit 1771
August 15, 2007

